

REMARKS/ARGUMENTS

As a result of the Final Office Action, Applicant's Claims 23, 25-31, 33-35 and 37-42 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,445,694, "Internet Controlled Telephone System," (Swartz).

Claims 24, 32 and 36 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Swartz in view of U.S. Patent No. 6,442,242, "Multifunction Autoattendant System and Method of Operation Thereof" (McAllister, et al.).

Applicant's independent claims 23, 31 and 35 have been amended make clear that Applicant's invention is directed to a technique for responding to a communication received from a sender, wherein the communication includes, *inter alia*, sender identification information. In one aspect of the invention, the sender identification information is used to search *publicly* available data for correlated information that is related to the sender. In one embodiment, set forth in Applicant's Detailed Description, the sender information is a caller ID. The caller ID may be used to search the Internet, or other publicly available sources of information, for information correlated with the caller ID, e.g., for an email address.

Because none of the cited references, nor any tenable combination of, or modification to, those references, discloses or suggests the subject matter of Applicant's Claims, including, in pertinent part, searching publicly available data for information that is correlated to the sender of the communication, Applicant respectfully maintains that Claims 23-42, as amended here, are patentable over the cited art.

Rejections Under 102(e)

Applicant's Claims 23, 25-31, 33-35 and 37-42 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Swartz. This ground for rejection of the above-referenced Claims is erroneous.

In rejecting the above-referenced Claims, the Final Rejection asserts that Swartz discloses searching for correlated information related to the sender. Final Rejection at page 2, section 2. However, the "search" disclosed in Swartz differs in significant respects from the search disclosed and claimed by Applicant. Specifically, Swartz' search is not performed on publicly available data. Rather, that search is highly restrictive in that it embraces only such information as has been previously entered by a subscriber, with respect to frequently called numbers. The subscriber-provided information is stored in a proprietary host services processor.

Accordingly, Applicant respectfully maintains that the rejection of independent Claims 23, 31 and 35 under 35 U.S.C. § 102(e) is erroneous.

A rejection of a claim under 35 U.S.C. § 102 requires that a prior art reference disclose expressly or inherently every limitation contained in the claim. *Rowe v. Dror*, 42 U.S.P.Q.2d 1550 (Fed. Cir. 1997). If any claimed element is absent from the reference, there is no anticipation. *Id.* A prior art reference must disclose each claimed element clearly enough to prove its existence in the prior art. *Motorola, Inc. v. Interdigital Tech. Corp.*, 43 U.S.P.Q.2d (Fed. Cir. 1984).

It is not enough, however, that the prior art references disclose all the claimed elements in isolation. Rather, as stated by the Federal Circuit, "[a]nticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the

claim. *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 U.S.P.Q. 481, 485 (Fed. Cir. 1984). The Federal Circuit has indicated that "[i]n deciding the issue of anticipation, the trier of fact must identify the elements of the claims, determine their meaning in light of the specification and prosecution history, and identify corresponding elements disclosed in the allegedly anticipating reference." *Id.* The anticipation determination is to be viewed from the perspective of one having ordinary skill in the art. There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. *Scripps Clinic & Research Found. v. Genentech Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991).

Applicant's independent Claims 23, 31 and 35 respectively recite a method, an apparatus and an article of manufacture that are directed to a technique for responding to a communication received from a sender. The communication, which may be a telephone call, includes sender identification information, e.g., a caller ID. The sender identification information is used to search publicly available data, such as may be accessible through the Internet, for example, for correlated information that is related to the sender. In this respect, Swartz, at Column 9, lines 27-39, discloses only a system in which a host services computer matches a telephone number to a "phone book" database. The "phone book" consists of frequently called listings that have been previously entered (manually, presumably) by the subscriber and contains only such information as is in the possession of the subscriber. Swartz at Column 10, lines 38-53.

Accordingly, based on the above salient differences between the subject matter that is set forth in Applicant's Claims 23,

31 and 35 and the subject matter disclosed in Swartz, Applicant respectfully maintains that Claims 23, 31, and 35 are patentable under 35 U.S.C. § 102(e) over Swartz.

Applicant's Claims 24-30, 32-34 and 36-42 depend, respectively, from independent Claims 23, 31 and 35 and are, for at least this reason, likewise patentable under 35 U.S.C. § 102(e) over Swartz.

Rejections Under 35 U.S.C. § 103(a)

Applicant's Claims 24, 32 and 36 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Swartz in view of McAllister, et al.

Applicant respectfully maintains that the above-referenced rejection of Claims 24, 32 and 36 is erroneous. Specifically, Applicant respectfully submits that there exists no legally tenable modifications to, or combinations of, Swartz and McAllister, et al. that render Applicant's Claims 24, 32 and 36 unpatentable.

In this regard, it must be recognized that hindsight reconstruction of claims based on disparate aspects of the prior art may not be employed as a valid basis for the rejection of those claims. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 220 U.S.P.Q. 303, 312-313 (Fed. Cir. 1983); *Panduit Corp. v. Dennison Manufacturing Co.*, 1 U.S.P.Q.2d 1593, 1595-1596 (Fed. Cir. 1987). Furthermore, it is clear that an obviousness determination requires that the invention as a whole would have been obvious when made a person having ordinary skill in the art. *Connell v. Sears Roebuck & Co.*, 220 U.S.P.Q. 193 (Fed. Cir. 1983).

Most, if not all, inventions arise from a combination of old elements. See *In Re Rouffet*, U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. See *id.* However,

identification in the prior art of each individual element claimed is insufficient to defeat patentability of the invention as a whole. See *id.* Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. See *In re Dance*, 48 U.S.P.Q.2d 1635, 1637 (Fed. Cir. 1998); *In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984). The motivation suggestion or teaching to combine references may come explicitly from the statements in the prior art, the knowledge of one with ordinary skill in the art, or, in some cases, the nature of the problem to be solved. *In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). Whether an Office Action relies on an express or implicit showing of a motivation or suggestion to modify or combine references, it must provide particular findings related thereto. *In re Dembiczak*, 50 U.S.P.Q.2d at 1617 (Fed. Cir. 1999). Broad conclusory statements standing alone are not "evidence." *Id.*

That is to say, with respect to the subject Patent Application, the Final Office Action must include particular factual findings that support an assertion that a skilled artisan would have combined or modified the express disclosures of Swartz and McAllister, et al. to develop the subject matter recited in the Applicant's Claims 24, 32 and 31. See *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1317. The specific subject matter set forth in Claims 24, 32 and 36 includes, in pertinent part, encoding an audio message received from a sender, composing an email message that includes the encoded audio message, and transmitting the email to a predetermined email address. Although conceding, *arguendo*, that McAllister, et al. discloses attaching an encoded audio message to an email, Applicant maintains that the Final Rejection nonetheless fails to make a

prima facie of obviousness based on Swartz in view of McAllister, et al. Particularly, nothing explicit or implicit in the disclosure of Swartz or McAllister, et al. suggests that those disclosures may be advantageously combined, and neither Swartz nor McAllister, et al. contains motivation to do so.

In rejecting Applicant's Claims 23, 32 and 36, the Final Rejection simply asserts that "it would have been obvious to one of ordinary skill in the art the time the invention was made to incorporate the use of the features of encoding the audio message; composing an email message that includes the encoded audio message and transmitting the email message to a predetermined email address, as taught by McAllister [sic], into view [sic] of Swartz in order to forward the voice messages to called party using a data network such as Internet."

It is apparent that the Final Rejection is tantamount to a bald assertion, without support, that it would have been obvious to combine Swartz and McAllister, et al. The Final Rejection flatly fails to provide a factual bases that substantiates a suggestion or motivation to combine those references. Nowhere does Swartz suggest that encoded audio messages be incorporated into emails sent to subscribers of Swartz's host services provider. Similarly, nowhere does McAllister, et al. suggest that a search be conducted of publicly available data so that correlated data related to the sender of the audio message may be obtained. McAllister, et al., in fact teaches away from Applicant's invention by indicating that necessary information may be solicited from the caller in the course of the call.

In addition, it is clear that the Final Rejection has been formulated by deconstructing the elements of Applicant's Claims 24, 32 and 36 and identifying individual ones of those elements in either Swartz or McAllister, et al. That is, the Final

Rejection is no more than a hindsight reconstruction of Applicant's disclosed invention.

The Final Rejection irrefutably appears to have merely engaged in the hindsight-based obviousness analysis that has been widely and soundly condemned by the Federal Circuit. In order to prevent a hindsight-based obviousness analysis, the Federal Circuit has clearly established that the relevant inquiry for determining the scope and content of the prior art is whether there is a reason, suggestion, or motivation in the prior art or elsewhere that would have led one of ordinary skill in the art to combine or modify references. See *Ruiz v. A.B. Chance Co.*, 57 U.S.P.Q.2d 1161, 1167 (Fed. Cir. 2000); see also *In Re Rouffet*, 47 U.S.P.Q.2d 1453, 1459 (Fed. Cir. 1998). ("[T]he Board must identify specifically... the reasons one of ordinary skill in the art would have been motivated to select the references to combiner them to render the claimed invention obvious.")

Applicant can detect, and the Final Rejection has pointed to, no motivation or suggestion that would prompt someone of ordinary skill in the art to look in either Swartz or McAllister, et al. for a solution to the problem addressed by Applicant's invention. Regrettably, there is reason to infer that the rejection in the Office Action of Claim 16 under 35 U.S.C. § 103(c) simply represents the "insidious effect of a hindsight syndrome wherein that which only [Applicants have] taught is used again rejection in [them]." See *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983). A determination that there is a suggestion or motivation to modify, or combine Swartz and McAllister, et al. is factual finding that is prerequisite to an ultimate conclusion of obviousness. *Sibia Neurosciences, Inc. v. Cadus Pharma. Corp.*, 55 U.S.P.Q.2d 1927, 1931 (Fed. Cir. 2000). Applicant

respectfully submits that the Final Rejection is devoid of such finding.

With respect to the subject Patent Application, the Final Rejection does not adequately support the selection and combination of Swartz and McAllister, et al. to render obvious that which only Applicant has described. Conclusory statements that "it would have been obvious...to incorporate the use of features...as taught by McAllister, et al. into view [sic] of Swartz in order to forward voice messages to a called party using a data network such as Internet" do not adequately address the issue of motivation to combine. See *In re Lee*, 61 U.S.P.Q.2d 1430, 1435 (Fed. Cir. 2001). The factual question of motivation to combine is material to patentability, and cannot be resolved on subjective belief and unknown authority. *Id.* (citing *W.L. Gore v. Garlock, Inc.*, U.S.P.Q. 303, 312, 313 (Fed. Cir. 1983)). The Final Rejection must not only assure that requisite findings are made based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the rejection of Applicant's Claims. *Id.*

Because the Final Rejection entirely fails to adduce any factual findings that would support, even inferentially, a motivation for, or suggestion of, the alchemy by which Swartz and/or McAllister, et al. might be combined or modified to yield the subject matter conspicuous in Applicant's Claims 24, 32 and 36, a *prima facie* case of obviousness in rejecting those Claim under 35 U.S.C. § 103(a) based on Swartz in view of McAllister, et al. has not been made. Accordingly, Claims 24, 32 and 36 are deemed patentable over the cited art.

CONCLUSION

In view of these remarks, the application is now in condition for allowance and the Examiner's prompt action in

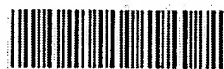
accordance therewith is respectfully requested. The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 20-1504.

Respectfully submitted,

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